

File



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/489,143	01/21/2000	William J. Baer	STL000020US1	5414
23373	7590	01/23/2004	EXAMINER	
SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			SMITH, PETER J	
			ART UNIT	PAPER NUMBER
			2176	13
DATE MAILED: 01/23/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/489,143

Applicant(s)

BAER ET AL.

Examiner

Peter J Smith

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 June 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5, 12.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to communications: application filed on 01/21/2000, IDS filed on 04/24/2000 and 09/30/2003.
2. Claims 1-24 are pending in the case. Claims 1, 9, and 17 are independent claims.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeRose et al. (hereafter referred to as DeRose), US 5,557,722 patented 09/17/1996 in view of Hartman et al. (hereafter referred to as Hartman), US 5,960,411 patented 09/28/1999.**

Regarding independent claims 1, 9, and 17, DeRose teaches random access rendering of electronic documents in fig. 3, 5-6, 9, the abstract, col. 9 lines 21-37, and col. 13 lines 17-40 which teaches determining a content count for a content object. DeRose does not teach determining from the content count a price for the content object. Hartman teaches in fig. 1C, 2, and col. 1 lines 32-45 determining a price for various content objects. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined Hartman into DeRose to have created the claimed invention. It would have been obvious and desirable to have used the commerce method of Hartman to have improved DeRose so that a content entities of customized price could have been traded electronically. It would have been

Art Unit: 2176

obvious and desirable to have done this so that the purchaser could have acquired only the content they desired without any extraneous parts.

Regarding dependent claims 2, 10, and 18, DeRose teaches determining a content count for each content entity and summing the entity content counts to obtain a content count for the content object in fig. 3, 5-6, 9, the abstract, col. 9 lines 21-37, and col. 13 lines 17-40. This information would have been inherently contained in DeRose because all the components of the electronic document would have been known in order to have performed the random access rendering of document.

Regarding dependent claims 3, 11, and 19, DeRose teaches determining a character count for the entity in fig. 3, 5-6, 9, the abstract, col. 9 lines 21-37, and col. 13 lines 17-40.

Regarding dependent claims 4, 12, and 20, DeRose teaches determining a page count from the character count in fig. 3, 5-6, 9, the abstract, col. 9 lines 21-37, and col. 13 lines 17-40.

Regarding dependent claims 5, 13, and 21, DeRose teaches counting the number of content characters in the content entity and determining the content entity type, and determining an average character count for content entities of that type in fig. 3, 5-6, 9, the abstract, col. 9 lines 21-37, and col. 13 lines 17-40.

Regarding dependent claims 6, 14, and 22, DeRose teaches random access rendering of custom electronic documents and maintaining a frequency count of elements, such as pages, in fig. 3, 5-6, 9, the abstract, col. 9 lines 21-37, and col. 13 lines 17-40. DeRose does not teach multiplying the page count with a predetermined price per page value. Hartman teaches multiplying a quantity with a predetermined price per item in fig. 1C, 2, and col. 1 lines 32-45.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined Hartman into DeRose to have created the claimed invention. It would have been obvious and desirable to have used the pricing system of Hartman to enhance DeRose so that the customized documents of DeRose could have been sold at variable prices to consumers.

Regarding dependent claims 7, 15, and 23, DeRose does not teach separately determining a price for user provided content and summing it with the price determined for the remaining content entities of the content object. Hartman does teach determining a price for different content items and summing them together to provide a total price in fig. 1C, 2, and col. 1 lines 32-45.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined Hartman into DeRose to have created the claimed invention. It would have been obvious and desirable to have used the pricing system of Hartman to enhance DeRose so that the customized documents of DeRose could have been sold at variable prices to consumers.

Regarding dependent claims 8, 16, and 24, DeRose does not teach wherein the price for user-provided material is determined in a first manner if the content count exceeds a predefined content count maximum, and is determined in a second manner if the content count does not exceed the predefined maximum. Charging a different price, such as adding fees, for exceeding a maximum limit was well known in the art at the time of the invention. Examples are fees for over charging a credit card or exceeding a predefined mileage on a leased car. The opposite can be true as well as some retailers discount a price if a certain minimum volume of

Art Unit: 2176

items are sold to a single customer at one time. It would have been obvious to have combined these techniques with DeRose in view of Hartman to render the claimed invention so that the it could be economically competitive.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Okayama et al., US 6,594,646 B1 filed 12/28/1999 discloses a digital contents selling system. Sachs et al., US 6,331,865 B1 filed 10/16/1998 discloses electronically distributing and viewing digital contents through use of a virtual bookstore.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter J Smith whose telephone number is 703-305-5931. The examiner can normally be reached on Mondays-Fridays 7:00am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H Feild can be reached on 703-305-9792. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

PJS
January 7, 2004


JOSEPH H. FEILD
PRIMARY EXAMINER